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Art Unit: 2141

Docket No.: PALM-3215

Remarks

Reconsideration and allowance are requested. Claims 1, 2, 8, 9, 15 - 16 have been amended to clarify their language and not to introduce limitations over the prior art. In many instances, the claims are made broader by the above amendments.

Rejection of Claims 1-2 and 8-9 Under Section 103

On page 2 of the Office Action, the Examiner rejected claims 1-2 and 8-9 under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,101,531 to Eggleston et al. ("Eggleston") in view of U.S. Patent No. 6,038,603 to Joseph ("Joseph"). While Applicants have amended the claims, as mentioned above, these amendments are not to introduce limitations over the prior art but to clean up and clarify the claims.

Applicants traverse the rejection and respectfully submit that under the obviousness standard, which governs when it is appropriate to combine references to reject claims, these references should not be combined. We'll first discuss some sections of the MPEP regarding obviousness and then address the teachings of the prior art.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

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If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Furthermore, if the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. MPEP 2142.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991). MPEP 2143.01.

With these principles in mind, we will discuss below that by a preponderance of the evidence, there is insufficient suggestion or motivation to combine Joseph with Eggleston. Eggleston's invention is a system for communicating user-selected criteria from a wireless device 201 to a server type device 220. A review of their Background section reveals that their goal is to limit the amount of information communicated between a remote user and a host

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computer Col. 1, lines 56-58. Another goal related to limiting the data communicated between a remote user and a host is tariffs and billing of time or data. Col. 2. Clearly, the focus and goal of Eggleston is to provide features such as their virtual session manager (VSM) for maintaining a session-less communication path with a mobile client and a session-oriented communication path with a data processing device such as a host system. Col. 2, lines 55 - 68. Each of their 5 embodiments of the invention teaches mobile stations, remote communication units and the like. Clearly, Eggleston places himself in the context of wireless communications between a mobile station and a host system with a goal of reducing data transfer.

Joseph, in contrast, appears to be a completely host or server based communication invention using URLs. Even in the Abstract, Joseph clearly focuses the reader on a "first computer system" that issues communications to a "second computer system." FIG. 1 of Joseph shows the first computer system with its server 104 and a second computer system with its server 106 communicating via a wired backbone 109. Where Eggleston is worried about how much data is transmitted due to tariffs on bandwidth use, Joseph is focused on more efficient management while sharing resources between computer systems in a network environment. Col. 1, lines 12 - 16. In this sense, Joseph is attempting to increase the data that is transmitted over the backbone while Eggleston is trying to reduce the data transmitted. The users in the computer systems are communicating with the client computers 103, 105 of Joseph.

In Joseph, one needs to go not further than the Summary of the Invention to see that Joseph contemplates a system where the first computer server "talks" to the second computer server utilizing the URL and whether the URL contains values corresponding to other protocols. Where Joseph discloses a client system from which the URL is received, see FIG. 6 and Col. 7, he describes it as communicating with the communications medium 257 which is a repeater, switch, router, bridge, other local area network equipment, wide area network equipment and telecommunications network equipment. There is no hint or suggestion that the URL concept for

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computer systems communicating with each other would apply in a wireless or mobile context from Joseph. He never mentions the terms “mobile” or “wireless” or suggests that context for the URL features of his invention. He certainly could have provided a suggestion that these concepts could work for mobile device but he did not. Since there is no suggestion or motivation within the references themselves, in the Office Action, it appears that Examiner used information outside of the references to support the combination.

The Examiner recites the claim language of claim 1 when he explains the reason one of skill in the art would be motivated to combine Eggleston and Joseph. The reason on page 4 of the Office Action that the Examiner gives for the motivation or obviousness of the combination of these two references is that “such methods were conventionally employed in the art to allow the data transfer exchange manager of various network devices uniquely identifying a resource by URL....to be used in retrieving the resource.” Applicants respectfully traverse this reasoning. Another portion of the MPEP states that where the Examiner asserts that the claim invention would be “well within the ordinary skill of the art” because the references relied upon teach that all aspects of the claimed invention were individually known is not sufficient to establish a prima facie case without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Here, the Examiner has simply stated that the claimed feature is “conventionally employed” (which is the same as saying “well within the ordinary skill in the art”). The law requires objective reasons for combining the references.

With the scope of the references and the suggestive power of each reference discussed above, Applicants submit that there is a lack of sufficient motivation or suggestion to combine. Where Eggleston is focused on a wireless network and a desire to reduce bandwidth and the costs associated with transmitting data, Applicants submit that by a preponderance of the evidence, one of skill in the art would not be motivated to combine that teaching with Joseph

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which has no reference to anything wireless or mobile and is totally LAN or WAN - based. Joseph appears to desire to increase data transmission between computer networks in a LAN or WAN. Joseph's primary focus is on connecting computer servers and simply provides no suggestion or motivation to seek or incorporate his teachings into a wireless context like in Eggleston.

For these reasons, Applicants submit that the Examiner, when taking the entire teachings and suggestive power of each reference into consideration, that by a preponderance of the evidence, it is not obvious to combine these references. Therefore, claims 1 - 2 and 8 - 9 are patentable and in condition for allowance.

Rejection of 3-7 and 10-14 Under Section 103

On page 5 of the Office Action, the Examiner rejected claims 3-7 and 10-14 under 35 U.S.C. 103(a) as allegedly being unpatentable over Eggleston and Joseph, further in view of U.S. Patent No. 6,295,541 to Bodnar, et al. ("Bodnar"). Applicants traverse the rejection and primarily submit that based on the arguments set forth above, the Examiner has not established a prima facie case of obviousness. Furthermore, since Eggleston should not be combined with Joseph, claims 3 - 7 and 10 - 14 are patentable and in condition for allowance.

Furthermore, Bodnar's teachings and suggestive power also do not support motivation to combine its teachings. The focus of Bodnar is on how to handle synchronizing two or more different datasets. These datasets are such as addresses, phone numbers, etc. The Abstract makes it clear very quickly that Bodnar is concerned with how to manage and synchronize these various types of personalized datasets. Applicants respectfully submit that this focus leads one of skill in the art away from combining these teachings with teachings from Joseph. Joseph teaches various computer servers each with a different function. Col. 3, lines 6 - 16 is where Joseph sets up the problem where each respective server performs different functions (mail,

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scheduling, etc.) using different protocols. Joseph never mentioned “synchronization” or suggests any desirability to synchronize the various databases and servers. Notably, Joseph teaches away from synchronization by setting up the problem that he addresses as an issue where the data and resources are not duplicated but spread out across the servers, thus the need for sharing those resources over the network as his invention addresses.

Therefore, for this additional reason, Applicants submit that by a preponderance of the evidence, one of skill in the art would not be motivated to combine Bodnar with Joseph and thus claims 3 - 7 and 10 - 14 are patentable and in condition for allowance.

Rejection of Claims 15-21 Under Section 103

On page 7 of the Office Action, the Examiner rejected claims 15-21 as allegedly being unpatentable under Section 103 over Eggleston, Joseph and Bodnar, further in view of U.S. Patent No. 6,317,777 to Skarbo, et al. (“Skarbo”). As stated above, Applicants have established that there is insufficient motivation or suggestion to combine Eggleston with Joseph and further to combine Joseph with Bodnar. Therefore, for those reasons, Applicants submit that claims 15 - 21 are patentable.

In addition, Applicants note that Skarbo teaches a method for storage and retrieval of documents in the context of document-collaborating videoconferencing. The Abstract introduces the invention of Skarbo where a system includes a document server and a conferencing computing system and how the local presenter computing system will transfer a document to the document server over a network. Applicants submit that one of skill in the art would not be motivated to combine these teachings with a reference such as Eggleston in that Eggleston is focused as set forth above on communication with a wireless client. In fact, Skarbo teaches away from any blending of its teachings with Eggleston where Skarbo states that “Generally, the data can be quite large, and there are few easily portable resources that also have

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capacity to hold large data.” Col. 1, lines 25 - 27. Therefore, Skarbo from the initial column would lead one of skill in the art away from mobile solutions as is the context of Eggleston. Therefore, by a preponderance of the evidence, Applicants submit that there is insufficient motivation or suggestion to combine Skarbo with Eggleston.

For these reasons, Applicants submit that claims 15 - 21 are patentable and in condition for allowance.

CONCLUSION

Having addressed all rejections, Applicants respectfully submit that the attached amendment places the subject application in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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